IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: LIAM D. COMERFORD ET AL.	)
	) Group Art Unit:
Serial No.: 10/674,131	) 2626
609	) Examiner:
Filed: September 29, 2003	) Godbold
	)
For: APPARATUS FOR THE COLLECTION OF DATA FOR PERFORMING AUTOMATIC SPEECH RECOGNITION	)

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

In response to the Final Office Action mailed March 19, 2009, and in conjunction with the concurrently filed Notice of Appeal, Applicants request a Pre-Appeal Brief Conference in view of the following remarks.

REMARKS

In response to the final Office Action dated March 19, 2009, Applicants respectfully request reconsideration in a Pre-Appeal Brief Conference based on the following remarks. Reconsideration and allowance of the claims are respectfully requested in view of the following remarks.

Claim 14 was rejected under 35 U.S.C. § 112, second paragraph. Applicants can overcome this rejection by amendment once the prior art rejection is removed.

Claims 1-3, 6, 14, 15, 18, 19, 21, 22, 26, 27, 29 and 31 were rejected under 35 U.S.C. § 103 as being unpatentable over Gordos in view of Marshall and Rubis. This rejection is traversed for the following reasons.

Claim 1 recites "wherein the illumination source is periodically energized by a pulse generator having a pulsed output, wherein a period of the pulsed output and a pulse width of the pulsed output are independently controlled to provide current to the illumination source." Neither Gordos nor Marshall teaches or suggests this feature. The Examiner relies on Rubis as allegedly teaching this feature. Rubis is related to a correction circuit, which is used to correct for electronic drifting. The correction circuit cancels system drift by periodically setting the system input to zero for very short time intervals, sampling the electronic system output, and supplying a correction signal through a long term servo memory, until the next sampling time (Column 1, lines 31-36). There is no indication in Gordos or Marshall that such a correction circuit would be needed, nor is there any indication that the correction circuit of Rubis would be functional in the apparatus taught by Gordos or Marshall. It is not clear how the correction circuit of Rubis would be used in Gordos or Marshall. The Examiner has not pointed out what supposed electronic drifting occurs in Gordos or Marshall.

The Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* issued by the PTO are relevant. The Guidelines state that a "prior art reference (or references when combined) need not teach or suggest all the claim limitations; however, Office personnel must explain why the difference(s) between the prior art and the claimed invention would

have been obvious to one of ordinary skill in the art. The 'mere existence of differences between the prior art and an invention does not establish the invention's nonobviousness.' The gap between the prior art and the claimed invention may not be 'so great as to render the [claim] nonobvious to one reasonably skilled in the art.'" Applicants submit that there is no reasonable combination of Gordos, Marshall and Rubis that results in the features of claim 1, and that the gap between the prior art and the claimed invention is too great to render claim 1 obvious.

The Examiner states that Marshall teaches that an oscillator may energize the illumination source and that Rubis is cited to teach independently controlling certain aspects of a pulse signal. This does not change the fact that Rubis is non-analogous art. The pending claims, Marshall and Gardos all relate to speech recognition. Rubis is from the field of compensating for circuitry drift due to temperature, aging, environment (Column 1, lines 8-10). Rubis teaches a compensating circuit that is put parallel with the drifting system (See Figure 1). As described in further detail herein, the pulse generator 47 and pulse stretcher 49 cited by the Examiner are used to close relays. The pulse generator 47 and pulse stretcher 49 are irrelevant to lighting a light source. The *KSR* decision did not eviscerate the law concerning non-analogous art. As noted in MPEP 2141.01(a), the examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "Under the correct analysis, any need or problem known in the field of endeavor at the time of the invention and addressed by the patent [or application at issue] can provide a reason for combining the elements in the manner claimed." *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1397 (2007). In the present case, Rubis is clearly non-analogous and not properly relied upon in an obviousness rejection.

Further, the KSR decision dictates that the proposed combination of prior art must provide a predictable result. This predictable result is lacking in the present case. The pulse generator 47 and pulse stretcher 49 in Rubis, cited by the Examiner in rejecting claim 1, are not used to illuminate a light source. The output of these devices is used to drive relays 10, 20, 30, 40, 50, and 60 in Figure 1. This allows the drift correcting circuit to sample the state of the drifting system 11. It is not at all clear how including the pulse generator 47 and pulse

stretcher 49 of Rubis in Marshall would provide a predictable result. There is no indication in Rubis that the period T and pulse width τ are sufficient to drive a light source. Any one skilled in the art would recognize that electrical devices cannot simply be connected and be predictably operational. The *KSR* decision does not stand for the doctrine that mere existence of claim elements in the prior art renders the claim obvious. To interpret *KSR* in this fashion would effectively render all subject matter unpatentable. Thus, Applicants submit that the proposed combination of Gordos, Marshall and Rubis.

For at least the above reasons, claim 1 is patentable over Gordos in view of Marshall and Rubis. Claims 2, 3, 6, 14, 15, 18, 19, 21, 22, 26, 27, 29 and 31 variously depend from claim 1 and are patentable over Gordos in view of Marshall and Rubis for at least the reasons advanced with reference to claim 1.

Claims 4 and 5 were rejected under 35 U.S.C. § 103 as being unpatentable over Gordos in view of Marshall, Rubis and Cofer. Claims 7 and 30 were rejected under 35 U.S.C. § 103 as being unpatentable over Gordos in view of Marshall, Rubis and Lahr. Claim 8 was rejected under 35 U.S.C. § 103 as being unpatentable over Gordos in view of Marshall, Rubis and Harman. Claims 9 and 20 were rejected under 35 U.S.C. § 103 as being unpatentable over Gordos in view of Marshall, Rubis and Paterson. Claims 10-13 were rejected under 35 U.S.C. § 103 as being unpatentable over Gordos in view of Marshall, Rubis and Jones II. Claim 16 was rejected under 35 U.S.C. § 103 as being unpatentable over Gordos in view of Marshall, Rubis and Tomioka. Claim 28 was rejected under 35 U.S.C. § 103 as being unpatentable over Gordos in view of Marshall, Rubis and Neal. With respect to these rejections, none of the relied upon secondary references cure the deficiencies of Gordos in view of Marshall and Rubis discussed above with reference to claim 1. As these claims all depend from claim 1 and are patentable for at least the reasons advance with reference to claim 1.

In view of the foregoing remarks and amendments, Applicants submit that the above-identified application is now in condition for allowance. Early notification to this effect is respectfully requested.

If there are any charges with respect to this response or otherwise, please charge them to Deposit Account 50-0510.

Respectfully submitted,

By: _____

David A. Fox
Registration No. 38,807
CANTOR COLBURN LLP
20 Church Street
22nd Floor
Hartford, CT 06103-3207
Telephone (860) 286-2929
Facsimile (860) 286-0115
Customer No. 48915

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